

hc



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,820	12/13/2001	Kin-Ping Wong	AN 2004.00	5971
7590 11/14/2003 McCutchen Doyle Brown & Enersen LLP Suite 1800 Three Embarcadero Center San Francisco, CA 94111-4067			EXAMINER LILLING, HERBERT J	
			ART UNIT 1651	PAPER NUMBER

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

Address : COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

10-021820

EXAMINER

ART UNIT

PAPER

20031113

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

Receipt is acknowledged of the restriction response filed September 22, 2003. Applicant has elected with traverse Group VIII, claims 26, 30, 31 and 33 and requested Group IV be rejoined based on the allegation that there is no serious burden on this Examiner to search and examine the additional invention. There is a very serious burden to search and examine additional inventions however Applicant may change the election in view of the following:

According to F.P.: Ochiai/Brouwer Rejoinder form paragraph

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection is governed by 37 CFR 1.116; amendments submitted after allowance is governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

If Applicant elects a composition/product claim, then all processes based on the allowed composition/product claim would be rejoined which would include the process of making the composition/product or using the composition/product as long as there are no 112 problems.


Applicant may change the election but the claims searched and examined would be directed only towards the elected invention and the withdrawn claims would be considered to be rejoined upon the allowance of the composition/product claims. The above rejoinder does not apply to two different process claims.

Applicant is requested to respond to this within one month from date of this action otherwise I will examine the elected invention as indicated, Group VIII.

Ser No 10/021,820  
Art Unit 1651

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is (703) 308-2034 and Fax Number is for applications Before Final (703) 872-9306 and After Final for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL  
(703) 308-2034  
Art Unit 1651  
November 13, 2003

  
HERBERT J LILLING  
Primary Examiner  
Art Unit: 1651